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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,878	08/29/2001	Emmanuel Lazaridis	1372.61.PRCWOUS	5633
21901	7590	12/21/2004	EXAMINER	
SMITH & HOPEN PA 15950 BAY VISTA DRIVE SUITE 220 CLEARWATER, FL 33760			MILLER, MARINA I	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/940,878

**Applicant(s)**

LAZARIDIS, EMMANUEL

**Examiner**

Marina Lebedeva

**Art Unit**

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/22/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The applicant was required to elect among groups drawn to different inventions. The applicant elected Group II, claims 21-36, drawn to molecular biology processes. This case has been transferred to the 1631 AU. The examiner understands that the applicant properly responded to the restriction/election requirement. However, the current examiner has determined that the following restriction and election of species applies to the pending claims. Applicants is required to elect from the following:

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a method for identifying latent classes, classified in class 706, subclass 46.
- II. Claims 15-17, drawn to a computer-implemented method for identifying latent classes comprising steps different from those of Group I, classified in class 702, subclass 19.
- III. Claims 18-20 and 31, drawn to a method of classifying objects, classified in class 702, subclass 19.
- IV. Claims 21-23, drawn to a method for identifying genes, classified in class 702, subclass 20.
- V. Claims 24-25, drawn to a method of determining in a sample a gene linked to disease, classified in class 702, subclass 20.

- VI. Claim 26 and 34, drawn to a method of identifying, in a library, a gene linked to metastasis, classified in class 435, subclass 6.
- VII. Claims 27-28, drawn to a method of predicting, classified in class 702, subclass 19.
- VIII. Claim 29, drawn to a method of screening for a drug, classified in class 435, subclass 6.
- IX. Claim 30, drawn to a method for identifying genes using variables as a matrix in a multidimensional space, classified in class 703, subclass 2.
- X. Claim 32, drawn to a method of classifying objects, classified in class 702, subclass 19.
- XI. Claim 33, drawn to a method of generating rules, classified in class 703, subclass 2.
- XII. Claim 35, drawn to a method of identifying genes linked to a condition of interest, classified in class 703, subclass 2.
- XIII. Claim 36, drawn to a method for analyzing an image of objects, classified in class 382, subclass 128.

The inventions are distinct, each from the other because of the following reasons:

The methods of Invention I-XV can be shown to be distinct because they are physically and functionally different, and are not required one to the other. In instant case of distinct inventions, each method has a different goal and method steps. Each method includes steps requiring manipulation of data are not required for the other methods.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for each group is not coextensive with that required for the other groups, restriction for examination purposes as indicated is proper.

***Specie Election Requirement***

This application contains claims directed to the following patentably distinct species of the claimed invention:

Specie A: an algorithm as recited in claims 11-13.

Specie B: a cellular phenotype as recited in claims 23.

Specie C: a morphogenetic descriptor as recited in claim 28.

Species of group A, different solutions are divergent because parameters represented by the solutions are different and independent from each other. Data generated from one type of solution is expected to be different from data generated by any other type of profile.

Species of group B, a disease, a cellular process, a physiological pathway, a signaling pathway, a protein, and a drug effect are distinct because they are structurally unrelated, and each has a distinct chemical composition and function, therefore data for each phenotype are independent.

Species of group C: different morphologic descriptions are distinct because they are generally described in separate arts and data obtained by model are different type of data and independent from each other.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1-10, 14-22, 24-27, 29-36 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lebedeva whose telephone number is (571)272-6101. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-0722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lebedeva  
Examiner  
Art Unit 1631

ml

MARJORIE MORAN  
PATENT EXAMINER

*Marjorie Moran*  
*12/14/09*